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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,418	07/07/2000	Raymond P. Johnston	54971USA3A.006	8574
32692	7590	12/07/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			MARSCHEL, ARDIN H	
PO BOX 33427			ART UNIT	
ST. PAUL, MN 55133-3427			PAPER NUMBER	

1631

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/612,418

Applicant(s)

JOHNSTON ET AL.

Examiner

Ardin Marschel

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of reasons of record as further explained as attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, ~~the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.~~

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-9, 13, 39-41, 43-46, 49, 50, 53, 54, 60, 61, 72-75, 77, & 81-85.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Exr. Int. Sum. of 12/6/04

com. Nn  
12-6-04

### **DETAILED ACTION**

Further explanation of item # 5 on the enclosed Advisory action:

The rejection of all presently pending claims based on NEW MATTER in claim 1 is maintained and reiterated from the previous office action, mailed 6/8/04. As described in the previous office action, mailed 6/8/04, the pointed to description on page 18, lines 15-23, failed to disclose written support for the amendment to instant claim 1 regarding particular acquisition to detection zone spontaneous fluid transport. Applicants now further argue that page 24, lines 16-20, provide written support for this amendment in instant claim 1. Consideration of said page 24, lines 16-20, citation reveals that the claim 1 limitation is not supported therein as being directed to spontaneous fluid transport but rather a more limited version wherein the transport is "spontaneous and uniform fluid transport". This more limited version which requires not only spontaneous fluid transport but "also" uniform fluid transport is not consistent with the claim 1 limitation which lacks any uniform requirement. Thus, the more generic limitation regarding acquisition to detection zone spontaneous fluid transport has not been found as filed and remains NEW MATTER due to broadening the description of the invention compared to what was originally filed. Applicants further argue that the specification, drawings and originally filed claims provide a clear description of the present invention and point specifically to claim 1 as originally filed. In response a thorough review of the specification, drawings, and originally filed claims has failed to provide written basis for the claim 1 amending as indicated as containing NEW MATTER. Additionally, consideration of claim 1 as originally filed lacks any description of spontaneous fluid transport between the acquisition and detection zones and therefore fails to provide written support for the presently pending claim 1 which still contains said NEW MATTER. Applicants argue that numerous instances of

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spontaneous fluid or liquid transport throughout the specification and original claims coupled with the description and drawings of channels including the acquisition zone and detection zone clearly supports the language of claim 1. Again, in response, a thorough review of the specification, drawings, and originally filed claims has failed to provide written basis for the claim 1 amending as indicated as containing NEW MATTER, nor have applicants pointed to any supportive description(s) therein for the specific wording amended into claim 1 which is still deemed NEW MATTER.

The prior art rejection of claims 1-3, 5-7, 13, 39-41, 43-46, 53, 54, 60, 61, 72-75, 81, and 83-85 based on Alajoki et al. (P/N 6,416,642) is maintained and reiterated from the previous office action, mailed 6/8/04. As described in the previous office action, mailed 6/8/04, this rejection would be maintained whether the above NEW MATTER rejection was withdrawn or not.

Applicants argue firstly by summarizing specification citations etc. regarding spontaneous fluid transport. These summarizations however do not seem to contain any argument directed at distinguishing the instantly claimed invention over the cited prior art and therefore are acknowledged but not persuasive. Applicant then argue that the addition of absorbent material to induce wicking in Alajoki et al. constitutes an external agency or external influence, force, cause or treatment. In response the instant claims are drawn to a device with characteristics cited in the claims. Such a device is assembled from its parts as does Alajoki et al. for its invention description. Absorbent material in the device of Alajoki et al. is internal to the device after its placement therein and thus is not an external agency, external influence, force, cause or treatment. The rejection is based on the assembled device of Alajoki et al. which anticipates the instantly claimed invention and not on its method of preparation. This argument is

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therefore non-persuasive as it is not directed to the basis of the rejection which is the device of Alajoki et al. whatever its manner of assemblage is.

The prior art rejection of claims 1-7, 39-41, 43-46, 49, 50, 53, 54, 60, 61, 72-75, 81, and 83-85 based on Christian (P/N 4,673,657) is maintained and reiterated from the previous office action, mailed 6/8/04. As described in the previous office action, mailed 6/8/04. As described in the previous office action, mailed 6/8/04, this rejection would be maintained whether the above NEW MATTER rejection was withdrawn or not.

Applicants argue that a solenoid roller is described in the reference which is an external application of force causing fluid movement and does not qualify as spontaneous fluid transport as instantly claimed. In response the solenoid roller is reasonably a part of the device of Christian and therefore not external to the device. Additionally, the instant claims lack any limitation which would distinguish such a solenoid roller content of a device as being external. The spontaneous fluid transport limitation in instant claim 1, for example, lacks any external limitation practice exclusion.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 6, 2004

*Ardin H. Marschel* 12/6/04  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER